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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/932,745 | 08/17/2001 | Todd Hoekstra | HOE002USPT01 | 4601 |

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EXAMINER

PARADISO, JOHN ROGER

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3721

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,745

Applicant(s)

HOEKSTRA, TODD

Examiner

John R Paradiso

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,19-21,23,38,39 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,19-21,23,38,39 and 50-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on 11/15/2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/932,745 is acceptable and a CPA has been established. An action on the CPA is attached.

Claim Objections

2. The listing of claims filed 11/15/2004 objected to because of the following informalities:
 - Claim 18 was previously cancelled (in amendment filed 2/17/04)
 - Claims 50-52 should be labeled (Previously Presented) since they were already presented in amendment filed 2/17/2004)

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-5, 7, 9-16, 19-21, 23, 38, 39, and 50-52 are rejected under 35 U.S.C. j 103(a) as being unpatentable over WEISS ET AL (US 6117505) in view of OTSU ET AL (US 6449925)

WEISS ET AL discloses an article comprising a longitudinally continuous web comprising two superimposed layers: a first layer (11, 12) that is a gas-permeable microbial barrier layer and a second layer (13) that is a thermoplastic gas impermeable layer. (See WEISS ET AL col. 6:3-31, and Fig. 1-2.)

WEISS ET AL does not disclose perforations / lines of weakness in the first and second layers at the same positions. WEISS ET AL implies, but does not specifically disclose the layers being formed from continuous webs.

OTSU ET AL (US 6449925) discloses a longitudinal web comprising a first layer and a second layer, with the first and second layer superimposed upon one another and longitudinally spaced lateral lines of weakness / perforations made in both layers at the same points so that the packages can be separated. (See OTSU ET AL col. 3:1-7 and Figs. 1 and 3.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make longitudinally spaced lateral lines of weakness / perforations, as taught by OTSU ET AL, in the invention of WEISS ET AL in both layers at the same points in order to provide a convenient method for separating the bags from one another when needed for use.

The recitations in claims 1 and 14 of "to be sterilized by sterilizing gas passed through the permeable layer", the recitation in claim 38 of "permitting the passage of a sterilizing gas", and the recitation in claim 50 of "may be sterilized and subsequently accessed with out fear of contamination by residues" are given little, if any, patentable weight since they amount to an intended use of the claimed article and it has been held that a recitation with respect to the

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manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Further, WEISS ET AL is capable of such use, if desired.

Regarding claims 2 and 3, Examiner notes that lines of separation and lines of perforation are art-recognized equivalents and it would have been obvious to one of ordinary skill in the art at the time the invention was made to make either lines of perforation or lines of weakness in either layer of the combination of WEISS ET AL and OTSU ET AL, depending on which was more convenient for a user when it was desired to separate the formed packages.

Regarding claims 7, 8, and 18, WEISS ET AL discloses a microbe-impervious peelable seal (B) near the lines of weakness / perforations (WEISS ET AL column 8:1-3).

Regarding claims 10, 20, and 51, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the choice of a spunbonded olefin as the first layer, since this material is well known in the art of packaging and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 11 and 21, the thermoplastic layer disclosed by WEISS ET AL is transparent.

Regarding claim 13, 23, and 52, OTSU ET AL does not disclose the specifics of the claimed perforations regarding area ratios and perfs per cm., however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the

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perforations in the combination of WEISS ET AL and OTSU ET AL of the claimed dimensions in order to achieve optimum perforation ease and utility, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 15, OTSU ET AL discloses forming the superimposed web layers into a roll (10) (OTSU ET AL Fig. 3)

5. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WEISS ET AL in view of OTSU ET AL as applied to claims 5 and 16 above, and further in view of MCINTOSH, SR. ET AL (US 4226410).

MCINTOSH, SR. ET AL discloses a web of material (16) which, after processing and perforating, is folded in a pleated stack (Fig. 1a)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to fold the finished articles in the combination of WEISS ET AL and OTSU ET AL in a pleated stack, as taught by MCINTOSH, SR. ET AL, in order to more easily package the stack in standard boxes.

Response to Arguments

6. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive.

7. Applicant states on page 1 of his Response that "The Examiner's response made clear he had not grasped the fact Applicant's disclosed and preferred embodiment is made up of interconnected preopened bags". Applicant continues on page 2 The claims of this application are directed to novel chains of pre-opened bags. "The art upon which the Examiner relies does not teach or suggest preopened bags."

However, Examiner believes he does have a "grasp" of Applicant's disclosure as well as the broadest reasonable interpretation of the claims. Examiner points out that neither the instant Specification nor the claims recite "pre-opened bags".

8. Applicant states on page 2 of his Response that "The Examiner seems to have totally ignored that aspect of the applicant's declaration, which states some of those licensees 'indicated they did not have the capabilities of producing such prototypes'".

However, this issue was not ignored: it was addressed in paragraph 8 of the Final Rejection, and Examiner still maintains that the fact that other manufacturers would or would not manufacture a prototype for Applicant is immaterial to the rejection. The only pertinent facts of the rejection are the disclosures of the references detailed in paragraphs 4-5 above and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references as explained.

9. Applicant states on page 3 of his Response that “Otsu does not teach tearable perforations. What he does teach in the referenced portion of column 3 is ‘perforations to facilitate cutting’. Applicant teaches tearing as distinguished from cutting. With cutting, one needs a tool. With tearing, one needs only a little manually applied force.”

However, the claims recite, variously, “lines of weakness” and “perforations”, but do not limit the method by which the separation of bags occurs. Examiner further notes that a line of weakness or perforation that facilitates cutting may also be tearable, and vice versa.

10. Regarding Applicant’s request (on page 4 of his Response) for clarification of how claim 18 is rejected, Examiner points out that claim 18 was rejected in the amendment filed 2/17/2004 and was therefore not included in the Final Rejection.

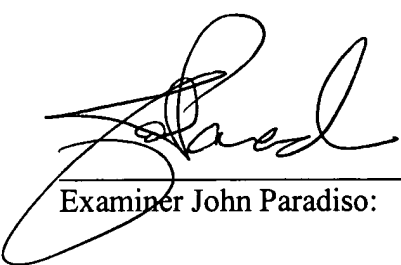
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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (571) 272-4466

December 13, 2004

Additional Phone Numbers:

Supervisor Rinaldi Rada: (571) 308-7135

Fax (Official): (703) 872-9306

Fax (Direct to Examiner) (571) 273-4466 (Drafts only)